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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,090	06/30/2003	Jean-Marie Bernard	004900-195	8126

7590 01/02/2008
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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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01/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/608,090	Applicant(s) BERNARD, JEAN-MARIE	
	Examiner Rabon Sergeant	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-35 and 37-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-35 and 37-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on September 28, 2007 and October 31, 2007 have been entered.
2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Since applicant has indicated that the originally filed claims provide support for claims 48 and 49, it is not clear that the relied upon subject matter has proper antecedence from the specification.
3. Claims 23-35 and 37-59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has failed to provide support and/or explanation for the amendment specifying that the modified stable polyisocyanates are not a foam. Applicant has stated that support for the language is present within page 3, lines 26-33. The examiner has considered this passage, and while it states that a foam is not produced, it does not state that the instant polyisocyanates are not a foam. The term, "foam", as used within the specification and as understood within the polyurethane art pertains to a polymeric foam structure; it does not pertain to monomeric

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polyisocyanate reactants; therefore, it cannot be determined from the cited passage exactly what applicant contemplates by the amendment. The examiner has considered applicant's argument that the modified stable polyisocyanates are not mere polyisocyanates monomers; however, it is unclear how this argument establishes that the instant polyisocyanates are not monomeric. In summation, since foams are polymeric and since the instant polyisocyanates are monomeric, it is unclear how the reference to foam further modifies the monomeric polyisocyanate.

4. Claims 23-35 and 37-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what limitation or significance is to be ascribed to the language stating that the polyisocyanates are not a foam. Since foams, by art-recognized definition are polymeric, and since polyisocyanates are understood to be monomeric or oligomeric, and therefore, non-polymeric, it is unclear how the language is to be interpreted.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 23-27, 30, 31, 33-35, 42, 45, 48, 50, 55, 56, and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 419114.


The reference discloses the reaction of polyisocyanates with cyclic carbonates having an isocyanate reactive substituent attached to the ring, and the use of the resulting product within polymers. See abstract and page 3, lines 1-8. Applicant has argued that the reference pertains to

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a polymeric foam; therefore, the instant claims, as amended, are distinguished from the reference. In response, while the reference does pertain to a polymeric foam product, applicant has not established that the reference does not disclose non-foamed polyisocyanate monomers that correspond to those claimed, since reactants equivalent to those of applicant are being used within the reference. Furthermore, as aforementioned, since polyisocyanates are monomeric and foams are polymeric, it is unclear how the amended language distinguishes the claims, since one would expect that pre-polymerized components or reactants cannot be polymeric foams. Additionally, despite applicant's response, in view of the fact that the reference employs the same reactants, applicant's response fails to conclusively establish that the polyisocyanates of the claimed structure are not encompassed by the reference. While applicant argues that the reference fails to disclose the presence of at least two isocyanate functions after conversion, applicant's argument fails to appreciate or consider that greater than difunctional polyisocyanates are disclosed by the reference.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
December 27, 2007


RABON SERGENT
PRIMARY EXAMINER